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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,034	09/29/2000	James Berger Camden	6643R2	3252

30113 7590 08/19/2002

THE PROCTER AND GAMBLE COMPANY  
INTELLECTUAL PROPERTY DIVISION  
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EXAMINER

DELACROIX MUIRHEI, CYBILLE

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 08/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/676,034	CAMDEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cybille Delacroix-Muirheid	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 November 2001.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4,6-12,14-20,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4,6-12,14-20,23 and 24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                           | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 . | 6) <input type="checkbox"/> Other: _____ .                                   |

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### **DETAILED ACTION**

The following is responsive to Applicant's amendment and terminal disclaimer received Nov. 30, 2001.

Claims 5, 13, 21, 22 are cancelled.

New claim 24 is added.

Claims 1-4, 6-12, 14-20, 23-24 are currently pending.

The previous claims objection set forth in paragraph 1 of the office action mailed Sep. 14, 2001 is withdrawn in view of Applicant's amendment and the remarks contained therein.

The previous claims rejections under 35 USC 103(a), set forth in paragraphs 2-5 of the office action mailed Sep. 14, 2001, are withdrawn in view of Applicant's amendment and the remarks contained therein.

The Terminal Disclaimer received Nov. 30, 2001 is not proper and has not been recorded because the attorney is not of record in the oath/declaration or a separate paper filed appointing a new or associate attorney.

The previous double patenting rejections set forth in paragraphs 7, 9, 10 are withdrawn in view of Applicant's amendment cancelling "-COOR1" from the claims.

The previous provisional double patenting rejection over 09/676,031 set forth in paragraph 8 of the office action mailed Sep. 14, 2001 is withdrawn in view of Applicant's amendment cancelling "-COOR1" from the claims.

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The previous provisional double patenting rejections over 09/676,202; 09/676,409; 09/676,029 **are withdrawn**. The claims in these applications are patented and the double patenting rejections are provided below.

***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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2. Claims 1-4, 6-12, 14-20, 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of USPN 6,423,736; claims 1-23 of USPN 6,420,411. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and USPN's '736 and '411 claim methods for treating a cancer (carcinoma, leukemia) and a viral infection in a warm-blooded animal, the methods comprising administering effective amounts of the claimed benzimidazole compounds. The difference between the instant application and USPN's 736 and '411 is that USPN's '736 and '411 claim a more limited subgenus of compounds. Yet, the scope of the claims of the instant application and USPN '736 and '411 overlap because at least one of the substituents identified for R in the instant application is identical to the substituents claimed in the patents, i.e. -NHCOR1 ('411), -CONR1R2 ('736).

Moreover, the compounds of the instant application are structurally similar isomers of the compounds claimed in USPN's '736 and '411 and are therefore obvious over one another.

3. Claims 1-4, 6-12, 14-20, 23, 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of USPN 6,423,735. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and USPN '735 claim methods for treating a cancer (carcinoma, sarcoma, leukemia) and a viral infection in a warm-blooded animal, the methods comprising administering effective amounts of the claimed benzimidazole compounds. The difference between the instant application and USPN '735 is that USPN '735 claims a more limited

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subgenus of compounds. Yet, the scope of the claims of the instant application and USPN '735 overlap because at least one of the substituents identified for R in the instant application is identical to the substituents claimed in the patents, i.e. -OCOR1.

Moreover, the compounds of the instant application are structurally similar isomers of the compounds claimed in USPN '735 and are therefore obvious over one another.

*Information Disclosure Statement*

Applicant's Information Disclosure Statement received Oct. 30, 2000 has been considered. Please refer to Applicant's copy of the 1449 submitted herewith.

*Conclusion*

Claims 1-4, 6-12, 14-20, 23, 24 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-4242.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

CDM



Aug. 12, 2002



Cybille Delacroix-Muirhead  
Patent Examiner Group 1600